

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VIKRAM RAI

Appeal 2007-1286
Application 09/849,088
Technology Center 2600

Decided: May 31, 2007

Before ROBERT E. NAPPI, JEAN R. HOMERE, and JOHN A. JEFFERY,
Administrative Patent Judges.

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 14. For the reasons stated *infra*, we affirm the Examiner's rejection of these claims.

INVENTION

Appellant invented a communication system, which allows a user to transmit information that does not have to be received in real time. The system allows a user to identify information that can be delivered to the recipient at a later time. See page 4 of Appellant's Specification. Claim 1 is representative of the invention and reproduced below:

1. A method for delivering user information over a communication system, the method comprising the steps of:

receiving user identified storable information comprising voice signals over a signaling channel; and

transmitting the received information to a destination over an available traffic channel.

REFERENCES

The references relied upon by the Examiner are:

Matsukane	US 5,467,341	Nov. 14, 1995
Boltz	US 6,044,275	Mar. 28, 2000
Sumner	US 6,091,947	Jul. 18, 2000

REJECTIONS AT ISSUE

Claims 1, 7 through 9, and 11 through 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Sumner. The Examiner's rejection is set forth on pages 3 through 5 of the Answer. Claims 2, 3, 5, 6, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sumner in view of Boltz. The Examiner's rejection is set forth on pages 5 through 7 of the Answer. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sumner in view of Boltz and Matsukane. The Examiner's rejection is set forth on page 7 of

the Answer. Throughout the opinion, we refer to the Brief (filed Nov. 1, 2005), and the Answer (mailed Jan. 27, 2006) for the respective details thereof.

ISSUES

Appellant contends that the Examiner's rejection under 35 U.S.C. § 102(e) is in error. Appellant argues that Sumner is silent as to receiving and transmitting "user identified storable information" as recited in the independent claims. Rather Appellant states:

Sumner teaches that the communication system decides whether or not a call should be routed to a voicemail deposit process (step 408) based on the transmission and/or reception rates. Thus, Sumner fails to teach or suggest user identified storable information. (emphasis original).

(Br. 6)

The Examiner contends that the rejection under 35 U.S.C. § 102(e) is proper. The Examiner states:

[C]laims 1, 9 and 12 do not require that the information be transmitted at a time specified by a user as argued by the appellant. The language of independent claims 1, 9 and 12 only requires the system to receive user identified storable information comprised of voice signals over a signaling channel and to transmit that information to a destination over a traffic channel.

(Answer 8).

Initially, we note that Appellant's arguments are directed to the anticipation rejection group all of the rejected claims together. In accordance with 37 C.F.R. § 41.37(c)(1)(vii), we group claims 1, 7 through 9, and 11 through 14¹ together and select claim 1 as a representative claim. The contentions of Appellant present us

¹ We note that claim 14 is a duplicate of claim 11.

with the issue of whether Sumner discloses receiving and transmitting “user identified storable information.”

FINDINGS OF FACT

Sumner teaches a wireless telephone messaging system. (Abstract). The system tests the communication signal to the wireless device, telephone. (See steps 401-406 of Figure 4 and col. 2, ll. 21-25). Based upon the results of the signal test, the system may prompt a caller to leave a voice mail for the user of the wireless device. (Col. 7, ll. 5-7, 60-64). The caller may leave a message. (See step 407 of Figure 4 and col. 7, l. 67). Implicit in prompting a user that they may leave a voice message is that the user decides to leave the voice message and not just hang up to call again later. A message if received from the caller is then transmitted to the wireless device. (See step 508 Figure 5 and col. 8, ll. 41-44).

PRINCIPLES OF LAW

Office personnel must rely on Appellant’s disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). “[I]nterpreting what is *meant* by a word *in* a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205 (Fed. Cir. 2002) (emphasis in original) (citing *Intervet Am., Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)).

However, the Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004) and our recent final decision in *Ex parte Curry*, 2005-0509 (BPAI 2007), *available at* <http://des.uspto.gov/Foia/ReterivePdf?flNm=fd050509.pdf> (Affirmed, Rule 36, Fed. Cir., slip op. 06-1003, June 2006).

ANALYSIS

Independent claim 1 recites “receiving user identified storable information comprising voice signals.” Appellant asserts, on page 3 of the Brief:

User identified storable information is information carried by a user signal that has been identified by the user as information that, once received by the system over a signaling channel, is to be transmitted (not in real time) by the system over an available traffic channel to its destination at a user (or system) specified time. See Patent Application, page 5, ll. 22-26.
(Br. 3)

We accept that Appellant’s Specification supports the proffered definition of the term user identified storable information. However, we find that this limitation is descriptive of the information and does not relate to a function of the method claimed. That is, that the information related to user identified storable information is not functionally related to the steps of receiving or transmitting. Thus, we do not find that this limitation will distinguish the claimed method from that of the prior art.

Nonetheless, we find that Sumner does teach transmitting user identified storable information. As discussed in our findings of fact, Sumner teaches that

through the signal test, the system determines whether the call will be connected or if the user will be prompted for voice mail. However, as also discussed *supra*, when the user is prompted to leave a voice mail, the user implicitly decides whether to leave a voice mail. Thus, the act of leaving a voice mail is an identification by the user (caller) that information comprising voice signals is to be sent to the user of the mobile phone. Thus, we find that Sumner does disclose the claimed “user identified storable information.” Accordingly, we sustain the Examiner’s rejection of claims 1, 7 through 9, and 11 through 14 under 35 U.S.C. § 102(e).

Appellant argues on pages 7 and 8 of the Brief that the Examiner’s rejections of claims 2 through 6, and 10 under 35 U.S.C. § 103(a) are in error for the same reasons discussed with respect to the rejection of claim 1 under 35 U.S.C. § 102(e). Further, Appellant argues that it would not be obvious to modify Sumner to meet the claimed invention as Sumner teaches away from “user identified storable information.”

We are not persuaded by this line of reasoning. As discussed with respect to the rejection of claim 1, we find that Sumner teaches “user identified storable information.” Accordingly, we sustain the Examiner’s rejections of claims 2 through 6, and 10 under 35 U.S.C. § 103(a) for the reasons discussed with respect to claim 1.

CONCLUSION

We sustain the Examiner’s rejection of claims 1, 7 through 9, and 11 through 14 under 35 U.S.C. § 102(e) and the Examiner’s rejections of claims 2 through 6, and 10 under 35 U.S.C. § 103(a). The decision of the Examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

tdl/ce

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